

In re Appln. of Verschueren et al.  
Application No. 10/808,812

### REMARKS

#### *The Pending Claims*

Claims 1-9 and 11- 21 are currently pending. Claims 1-7 and 11-21 are directed to a positive working heat-sensitive printing plate precursor. Claims 8 and 9 are directed to a stack and a package of positive working heat-sensitive printing plate precursors, respectively. Claim 11 is directed to a process for improving the scuff-mark resistance of a positive working heat-sensitive printing plate precursor.

#### *Amendments to the Claims*

Claim 10 has been canceled, with claims 11-21 being introduced in this response. No new matter has been added by way of these amendments.

#### *Summary of the Office Action*

The Office Action rejects claim 10 under 35 U.S.C. § 112, second paragraph and § 101.

The Office Action rejects claims 1-10 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent 6,593,057 (Kita).

#### *Discussion of the § 101 Rejection*

The rejection is moot in view of the cancellation of claim 10. Applicants respectfully request that the rejection be withdrawn.

#### *Discussion of the § 112, Second Paragraph Rejection*

The rejection is moot in view of the cancellation of claim 10. Applicants respectfully request that the rejection be withdrawn.

#### *Discussion of the Anticipation Rejection*

The Office Action rejects claims 1-10 as allegedly anticipated by Kita. Applicants respectfully traverse the anticipation rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Claim 1 of the present application requires, among other limitations, spacer particles, wherein the spacer particles comprise aluminum hydroxide or aluminum oxide and have an average particle size larger than 0.3  $\mu\text{m}$ . Kita does not disclose the use aluminum oxide or

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aluminum hydroxide particles with an average particle size greater than 0.3  $\mu\text{m}$ . Instead, Kita teaches that aluminum oxide or hydroxide particles of 100 nm x 100 nm (i.e. 0.1  $\mu\text{m}$  x 0.1  $\mu\text{m}$ ) are effective additives in the water-receptive layer of a heat sensitive lithographic plate precursor. See col. 6, lines 22-24. Thus, in not disclosing each and every element of claim 1, Kita does not anticipate claim 1. Furthermore, since claims 2-9 and 12-21 depend from claim 1, and claim 11 includes the coating described in claim 1, Kita does not anticipate claims 2-9 and 11-21. Applicants respectfully request that the anticipation rejection of claims 1-9 be withdrawn, and that all the pending claims be passed to issue.

Moreover, nothing in Kita would motivate one skilled in the art to modify the precursors described therein in a manner that would yield the claimed invention. For example, Kita teaches the inclusion of various particle types, all having a size that is significantly smaller as compared to the claimed aluminum hydroxide or aluminum oxide spacer particles. Thus, there is no teaching or suggestion in Kita that would motivate one to use particles of the material set forth in the claims (i.e., aluminum hydroxide or aluminum oxide) in the size as claimed. For at least these reasons, Kita does not render obvious any pending claims.

#### *Conclusion*

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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